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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,442	07/20/2001	Rajagopal Bakthavatchalam	NCX-003:01	2748

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MCDONNELL BOEHNEN HULBERT & BERGHOFF  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/04/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/910,442

Applicant(s)

BAKTHAVATCHALAM ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6,8-23,25-85,88-176,193 and 197-211 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6,8-23,25-85,88-176,193 and 197-211 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.                      6) ☐ Other:

**DETAILED ACTION**

1. Claims 4-6, 8-23, 25-85, 88-176 <sup>and</sup> 193, 197-211.

***Response to Amendment***

2. Applicant's amendment filed 2/10/2003 in response to the previous Office Action (Paper No. 10) is acknowledged. Rejections of claims 4-6, 8-176 and 193-198 under 35 U.S.C. § 112, second paragraph (Paper No. 10, paragraphs 8a-8b) have been obviated. The rejection in previous Office Action under 35 U.S.C. § 112, second paragraph (Paper No. 10, item 8c) has been maintained.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-6, 8 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Du et al. (US Pat. No. 4,450,272). The cited reference teaches the general preparation of 1-piperazine thiocarboxamide derivatives. Specifically, the 5<sup>th</sup>, 6<sup>th</sup>, 7<sup>th</sup>, 9<sup>th</sup>, and 10<sup>th</sup> compounds on Table III are the same as applicants. Said compounds are the same as applicant's compound when applicant's compound of the formula have the following substituents: Ar1 = phenyl, Ar2 = piperazinyl, A = NH, Z = S, R3=R4 = hydrogen.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6, 8-9, 27, 31-32, and 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There has been recited in claims 4, 5, 8, 9, etc. the term "heterocycle", but this term introduces a new matter.

Applicants have replaced the term "heterocycloalkyl" to "heterocycle" to overcome the rejection, but the new term is now broader. According to page 45 of the specification, "heterocycloalkyl" is defined as a stable 5-7 membered monocyclic or bicyclic or 7-10 membered bicyclic heterocyclic saturated ring." Heterocyclic ring includes both saturated and unsaturated rings, thus it is broader than "heterocycloalkyl." It is recommended that applicants amend the claim as "saturated heterocyclic ring." That will resolve the issue entirely.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6, 8-23, 25-85, 88-176, 193, and 197-211 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claims 4 or elsewhere in the claims, the phrase "optionally substituted" is indefinite. "Optionally substituted" by what? What are covered and what are not?

b. In claim 193, the phrase "the compound or salt is not addictive" is not clear.

How can one tell if the salt or the compound is addictive or not? How can one prove

that the salt or the compound is not addictive?

***Response to arguments***

Applicant's argument filed 02/10/2003 has been fully considered but they are not persuasive.


Applicants indicate that they have attached a copy of an article (American Psychiatric Association, 2000) pages 192-198 to overcome the rejection, but the examiner did not get the copy. It is recommended that applicants send the reference in response to this Office Action.

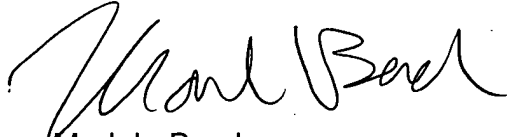
**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624

  
Mark L. Berch  
Primary Examiner  
Art Unit 1624

KH  
March 3, 2003